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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/845,737	04/30/2001	Brian T. Murren	GE1-006US	3462
21718	7590	09/06/2007	EXAMINER	
LEE & HAYES PLLC SUITE 500 421 W RIVERSIDE SPOKANE, WA 99201			SWEARINGEN, JEFFREY R	
			ART UNIT	PAPER NUMBER
			2145	
			NOTIFICATION DATE	DELIVERY MODE
			09/06/2007	ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

lhpto@leehayes.com

## Office Action Summary

Application No.

09/845,737

Applicant(s)

MURREN ET AL.

Examiner

Jeffrey R. Swearingen

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 07 August 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-30, 48-51 and 58 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-30, 48-51 and 58 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |                                                                                                            |                                                                                         |
|------------------------------------------------------------------------------------------------------------|-----------------------------------------------------------------------------------------|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                                           | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____                                                |

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## DETAILED ACTION

### *Response to Arguments*

1. Applicant's arguments with respect to claims 1-30, 48-51 and 58 have been considered but are moot in view of the new ground(s) of rejection.
2. No reasonable search of the prior art can be undertaken at this time on the invention based upon Applicant's inadequacies present in the specification and claims.

### ***Claim Rejections - 35 USC § 112***

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

4. Claims 1-30, 48-51 and 58 rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

5. As per MPEP 2164, The purpose of the [enablement] requirement that the specification describe the invention in such terms that one skilled in the art can make and use the claimed invention is to ensure that the invention is communicated to the interested public in a meaningful way. The information contained in the disclosure of an application must be sufficient to inform those skilled in the relevant art how to both make and use the claimed invention.

6. The test of enablement is "Any analysis whether a particular claim is supported by the disclosure in an application requires a determination of whether that disclosure, when filed, contained sufficient information regarding the subject matter of claims as to enable one skilled in the pertinent art to make and use the claimed invention...even though the statute does not use the term "undue experimentation", it has been interpreted to require that the claimed invention be enabled so that any person skilled in the art can make and use the invention without undue experimentation." MPEP 2161.01

7. MPEP 2164.01(a) details the factors presented by *In re Wands*, 858 F.2d 731, 737, 8 USPQ2d 1400, 1404 (Fed. Cir. 1988) to be considered in determining whether there is sufficient evidence to

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support a determination that a disclosure does not satisfy the enablement requirement and whether any necessary experimentation is "undue." These factors include, but are not limited to:

- a. The breadth of the claims: Applicant's own admissions speak to the breadth of the claims. Applicant stated the specification showed a "hierarchical organization of layers, which can be implemented as a hierarchical grouping of code modules. Hence, the term 'layer' would be well understood by one skilled in the art." One of ordinary skill in the art recognizes this definition to match the definition used for the OSI model of computer networking, which is a basic building block of networking theory. See Applicant Remarks, 4/28/2006, specifically Appendix B. In a telephonic interview conducted with Applicant's representative on 6/10/2006, the invention was described as an object-oriented software development environment. A response to a requirement for information under 37 CFR 1.105 revealed the invention was implemented as "GEtheSource", which is "a web-based asset management application developed for Global Electronics Solutions business of GE Commercial Equipment Finance." Remarks of 9/12/2005, page 41. Applicant has stated the claims are broad enough to cover the OSI model of computer networking, object oriented programming, and web based credit card billing systems.
- b. The nature of the invention: The invention is believed to be a software development system. This is supported by the original specification, page 2, lines 1-15.
- c. The state of the prior art: Object oriented software development platforms have been in existence several years before the invention was created.
- d. The level of one of ordinary skill: The inventor of the application is considered to have the level of one of ordinary skill.
- e. The level of predictability in the art: Networking is a predictable art. Unpredictable results are not common.
- f. The amount of direction provided by the inventor: If the invention is an object oriented software template, one of ordinary skill is unable to implement the specific invention based upon the submitted information within the specification. Applicant provided a source code snippet on page 57 of the specification for a login prompt for a screen. Table 5 gives another source code

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snippet implementing this as a login function for JavaScript. Various object abstracts are presented in Tables 18-30. Page 94 of the specification reiterates an HTML source code snippet for the login prompt, which is compiled on page 96. Table 1 is a document type definition of basic XML elements of data. Table 2 is "an example XML file for the asset catalog program." No information is provided explaining how these code snippets and XML file fragments are implemented as interchangeable layers. The closest information provided to an actual implementation of an object oriented program can be found by example in Table 5. Lines 8-30 of Table 5 call various functions, such as blsGELength, blsLELength, and bValidateTextTagUserName. These appear to be non-functional variables which are not referenced anywhere else in the specification, and are not called by any example in the specification. Applicant therefore has provided no examples of the implementation of the layers or domains that Applicant has claimed. One of ordinary skill has no foundational information to work with in order to implement these crucial aspects of Applicant's invention.

g. The existence of working examples; Applicant provided no working examples of the invention to the Office for review and

h. The quantity of experimentation needed to make or use the invention based on the content of the disclosure: Applicant provided a vague description of a set of various "layers" used to solve "problems" in "problem domains". Applicant referred to an "interfacing layer" in the claims, but gave no indication in the specification to allow one of ordinary skill in the art to interpret what this layer consisted of. The interfacing layer is never referenced in the specification or drawings. Specification, page 8 – "Generally, the architecture 110 includes an execution environment layer 202, a business logic layer 204, a data coordination layer 206, a data abstraction layer 208, a service layer 210, and a presentation layer 212." Although page 15, lines 18-26 states "[t]he architecture 110 may include one or more other layers or modules...", the subsequent text of that paragraph is directed to other modules which may be added to the architecture, and not toward any "interfacing layer".

### ***Conclusion***

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jeffrey R. Swearingen whose telephone number is (571) 272-3921. The examiner can normally be reached on M-F 8:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jason Cardone can be reached on 571-272-3933. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



Jason Cardone  
Supervisory Patent Examiner  
Art Unit 2145

JRS